



"PATENT"

Attorney Docket No.: P5502 (266101-000002)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Munoz et al.

Serial No. 09/316,725

Filed: May 21, 1999

For: A METHOD OF DETERMINING
TASK COSTS FOR ACTIVITY
BASED COSTING MODELS

Examiner: Thomas A. Dixon

Group Art Unit: 2161

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REPLY BRIEF

This reply is in response to the Examiner's Answer mailed April 19, 2005. Please consider the following remarks.

SUMMARY OF THE ISSUE

Independent claims 1 and 28 both recite *inter alia*:

said human operator using an operator independent method of task time measurement based on independently timing each motion in a procession of motions required to perform said healthcare task without timing from a beginning of said healthcare task to an end of said healthcare task a human performing said healthcare task;

The claims mainly stand rejected under 35 U.S.C. §103 as being obvious to the combination of LeVander (U.S. Pat. No. 6,216,108) in view of both Conway (U.S. Patent No. 5,732,401) and Dossett (Industrial Engineering Journal "*Work Measured Labor Standards – The state of the art*"). LeVander discloses measuring task time measurement by using historical data, and Conway discloses measuring how long a particular procedure takes in the healthcare field by timing how long personnel, such as a doctor, is in a particular room designated for a particular purpose (e.g. medical operating room). Dossett discloses a number of task time measurement methods including MOST, which totals the independent timing of particular human motions in order to determine the time for a task.

The Examiner asserted the following motivation to combine these references:

"...it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use the motion analysis technique or one of the others in a healthcare environment for the benefit of efficiently determining the actual cost of procedures and determining the particular efficient of a particular caregiver." Examiner's Answer, page 6, lines 37-40 and page 9, lines 17-20.

Applicants argued that (1) the references teach away from each other, and therefore, cannot be combined, and (2) the Examiner has failed to show that the prior art reveals a desirability for the invention as claimed. See Appeal Brief, Arguments, pages 6-10.

In response to Applicant's argument that both Conway and Dossett teach away from LeVander, the Examiner appears to respond that the fact that the references have different work measurement schemes that teach away from each other is irrelevant because all three references disclose work measurement used for similar reasons such as "to measure individual tasks" or for

“increasing productivity” or to “provide future estimates.” See, e.g. Examiner’s Answer, page 10, lines 3-8, 12-16. Thus, the Examiner appears to argue that since the MOST method is merely “one of many time and motion techniques”, the work measurement methods are interchangeable and the combination is therefore obvious. See Examiner’s Answer, page 9, line 21 to page 10, line 2. The Examiner adds that Applicant needs to show “unexpected results” in order to prove that the MOST method is an improvement in the medical field versus other fields. See page 10, lines 8-10.

**THE EXAMINER MUST LOOK TO THE COMBINABILITY OF THE
SPECIFIC TIME MEASUREMENT METHODS TO DETERMINE
IF THE COMBINATION IS DESIRABLE.**

The Examiner’s analysis of the references still ignores the requirement that the prior art reveal the desirability of the combination. See MPEP 2143.01.

It is well established that even though all the claimed features are disclosed by the prior art, a motivation must be found in the prior art that shows that the claimed combination is desirable. See Section II., Appeal Brief, page 8, lines 1-7.

The Examiner must disclose a reason that one measurement method should be replaced or modified by one of the other measurement methods to derive all of the claimed features, and the Examiner has not done this. Instead, the Examiner has merely stated general motivations such as increasing efficiency or productivity. See Examiner’s Answer, page 6, lines 37-40, and page 10, lines 3-8, 12-16. However, these statements do not reveal a motivation to replace one measurement method with any other measurement method. In fact, these motivations can apply

to any of the time measurement methods. Thus, the Examiner still has not found a specific motivation to use the MOST method in the healthcare field as claimed.

In order to determine if one measurement method should be replaced or modified by another measurement method, the Examiner must look to the reasons for using the specific measurement methods. As mentioned before, it appears that many different ways of examining a patient or performing the same medical operation exist. Appeal Brief, page 3, lines 3-4. Thus, it is not obvious to simply apply any task measurement method to healthcare tasks and, in fact, the Conway reference strongly teaches that it shouldn't even be tried. The Examiner's motivations for combining the references do not overcome this contrary teaching. See Appeal Brief, Section I., pages 6-7.

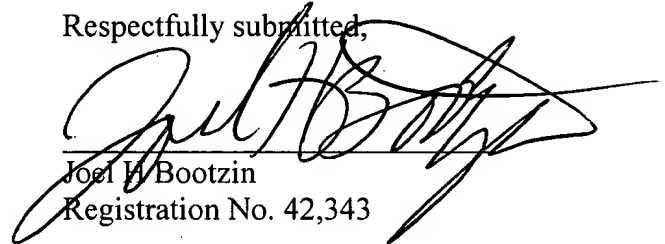
The Examiner is also mistaken about the burden in this case when he states that Applicants must show “unexpected results”. “[W]hile an ‘unexpected result’ [] may be evidence of obviousness, it is *not* a requirement.” *Panduit Corp. v. Dennison Manuf. Co.*, 227 USPQ 337, 348 (Fed. Cir. 1985) (vacated on other grounds) *citing Lindemann Maschinenfabrick GMBH v. American Hoist & Derrick Co.*, 730 F.2d at 1461, 221 USPQ at 448; *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1360-61 USPQ 763, 771 (Fed. Cir. 1984).

It is the Examiner's burden to establish a prima facie case of obviousness which requires the Examiner to show that the prior art discloses the desirability of the combination and a reasonable expectation of success. See MPEP 2142. Nowhere in the references is it disclosed that the MOST method would be successful in the healthcare field. To assume that it would be successful is the improper use of hindsight gained from applicants' disclosure.

For these reasons, Applicants submit the Examiner's rejection has been overcome and respectfully requests the rejection be withdrawn or overturned.

No fees are believed to be due for submitting this Reply Brief. However, the Director is hereby authorized to charge any deficiency, including, but not limited to the Reply Brief filing fee and any required time extension fee, to Deposit Account No. 18-2284 of DLA Piper Rudnick Gray Cary US LLP, duplicate copy attached.

Respectfully submitted,



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